

FEB 28 2006

Attorney Docket No: P-001

AMENDMENTS TO THE CLAIMS (Marked-up copy)

WHAT IS CLAIMED IS:

1. (Previously presented) A method of computerized generation of a derivative value enhanced document from a patent document, comprising the steps of:

(a) selecting a claim section of the patent document;

(b) processing the claim section, including:

(i) transforming multiple dependent claims into single dependent claims;

(ii) sorting the transformed claims by claim numbers to which the claims refer to;

(iii) interchanging positions of any two neighboring sorted claims, the preceding claim and the succeeding claim, if they meet the following requirements:

both claims are dependent claims and refer to different claims; and  
succeeding claim does not refer to the preceding claim;

(c) extracting claim dependency and text of claims from the interchanged claim section;

(d) converting the extracted claim dependency into a graphical form, comprising a set of graphical elements, each element corresponding to an individual claim or a group of claims;

(e) converting the extracted text of claims into a textual form, comprising a set of elements, each element being a text of an individual claim or a text of a group of claims;

(f) forming a derivative claim section by combining the converted graphical and textual elements of the converted claim dependency and text of claims in the order obtained after the step (iii) of interchanging; and

(g) forming the derivative document by combining the derivative claim section with the patent document or a part of the patent document.

2. (Previously presented) A method as described in claim 1, wherein the steps of converting further comprise establishing links between the elements of the graphical and textual subsets according to the transformed claim dependency.

3. (Canceled)

4. (Canceled)

5. (Previously presented) A method as described in claim 1, further comprising one or more of the following:

displaying the selected subsets of elements on a computer screen; and

displaying the selected subsets of elements on a computer screen in combination with other elements of the sets.

6. (Canceled)

7. (Previously presented) A method as described in claim 1, wherein the step (e) comprises converting into the form selected from the list consisting of ASCII, HTML, SGML, XHTML, and XML formats.

8. (Previously presented) A method as described in claim 1, wherein the step (g) comprises a step selected from the list consisting of:

forming the document so that the derivative claim section is replacing the claim section of the patent document;

forming the document so that the derivative claim section is supplementing the patent document;

forming the document so that the derivative claim section is supplemented by a part of the patent document; and

forming the document so that the derivative document is the derivative claim section of the patent document.

9. (Original) A method as described in claim 1, further comprising a step of performing one or more of the following:

storing data obtained in at least one of the steps in a database;

sending data obtained in at least one of the steps over a network;

compressing data obtained in at least one of the steps;

displaying one of the derivative document and the derivative segment on a computer screen.

10. (Previously presented) A method as described in claim 1, wherein the step (b) comprises distributed processing of the patent document in a network environment performed by using processing power of more than one computer.

11. (Original) A method as described in claim 10, wherein the step of distributed processing comprises the steps of initial processing of the document performed on a server side and final processing performed on a client side.

12. (Canceled)

13. (Previously presented) A method of computerized generation of a database stored in a memory, comprising the steps of:

- (a) providing a patent document;
- (b) performing the steps of the method as described in claim 1; and
- (c) storing data obtained in at least one of the steps of the step (b) in a database stored in the memory.

14. (Previously presented) A database stored in a memory and obtained according to the method as described in claim 13.

15. (Previously presented) A method of computerized generation of a derivative claim section from a patent document, comprising the steps of:

- (a) selecting a claim section of the patent document;
- (b) processing the claim section, including:
  - (i) transforming multiple dependent claims into single dependent claims;
  - (ii) sorting the transformed claims by claim numbers to which the claims refer to;
  - (iii) interchanging positions of any two neighboring sorted claims, the preceding claim and the succeeding claim, if they meet the following requirements:
    - both claims are dependent claims and refer to different claims; and
    - succeeding claim does not refer to the preceding claim;
- (c) extracting claim dependency and text of claims from the interchanged claim section;
- (d) converting the extracted claim dependency into a graphical form, comprising a set of graphical elements, each element corresponding to an individual claim or a group of claims;
- (e) converting the extracted text of claims into a textual form, comprising a set of elements, each element being a text of an individual claim or a text of a group of claims; and
- (f) forming a derivative claim section by combining the converted graphical and textual elements of the converted claim dependency and text of claims in the order obtained after the

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step (iii) of interchanging, and associating thereof with a computer program code providing a user interactive selection of a subset of elements in one of the graphical and textual forms, and displaying said subset in the selected form along with the related subset of elements according to the transformed claim dependency in the other form to a user, the elements in the graphical form being displayed in the order obtained after the step (iii) of interchanging.

16. (Previously presented) A method as described in claim 15, wherein the steps of converting further comprise establishing links between the elements of the graphical and textual subsets according to the transformed claim dependency.

17. (Canceled)

18. (Canceled)

19. (Previously presented) A method as described in claim 16, further comprising one or more of the following:

displaying the selected subsets of elements on a computer screen; and

displaying the selected subsets of elements on a computer screen in combination with other elements.

20. (Canceled)

21. (Previously presented) A method as described in claim 15, wherein the step (e) comprises converting into the form selected from the list consisting of ASCII, HTML, SGML, XHTML and XML formats.

22. (Previously presented) A method as described in claim 15, wherein the step (b) comprises distributed processing of the claim section in a network environment performed by using processing power of two or more computers.

23. (Previously presented) A method as described in claim 22, wherein the step of distributed processing comprises the steps of initial processing of the claim section performed on a server side and final processing of the claim section performed on a client side.

24. (Canceled)

25. (Previously presented) A computerized system for generating a derivative document from a patent document, comprising a computer having a memory, said memory comprising:

- (a) means for selecting a claim section of the patent document;
- (b) means for processing the claim section, including:
  - (i) means for transforming multiple dependent claims into single dependent claims;
  - (ii) means for sorting the transformed claims by claim numbers to which the claims refer to;
  - (iii) means for interchanging positions of any two neighboring sorted claims, the preceding claim and the succeeding claim, if they meet the following requirements:

- both claims are dependent claims and refer to different claims; and
  - succeeding claim does not refer to the preceding claim; and

- (c) means for adding a new section to the patent document or to a part thereof to form the derivative document, the new section comprising a computer program code for interactive displaying the transformed sorted and interchanged claim section or any part thereof, or a reference to a file where the computer program code resides, the computer program code being executable in response to an event.

26. (Original) A computerized system as described in claim 25, further comprising means for sending the derivative document over a network.

27. (Previously presented) A computerized system as described in claim 25, wherein the means (b) comprises means for distributed processing of the document in a network, wherein processing power of two or more computers is used.

- 28. (Canceled)
- 29. (Canceled)
- 30. (Canceled)
- 31. (Canceled)
- 32. (Canceled)
- 33. (Canceled)

34. (Canceled)

35. (Canceled)

36. (Canceled)

37. (Previously presented) A method as described in claim 1, wherein the step of selection of the subset of elements comprises the step selected from the list consisting of:

selecting the subset comprising only one element in one form, and displaying the selected subset in said one form with the related subset comprising the corresponding element of the other form;

selecting the subset comprising only one element in one form, and displaying the selected subset in said one form along with the related subset in the other form comprising first and second elements, wherein the first element corresponds to the selected element of the first form, and the second element is the element on which the first element refers to according to claim dependency;

selecting the subset comprising elements of one form corresponding to independent claims only, and displaying the selected subset in said one form along with the related subset in the other form comprising elements of the other form corresponding to the selected elements of said one form;

selecting the subset comprising elements in one form corresponding to an independent claim and all the dependent claims referred thereto only, and displaying the selected subset in said one form along with the related subset comprising elements in the other form corresponding to the selected elements in said one form; and

selecting the first subset comprising an independent claim only in one form, and displaying the selected subset in said one form along with the related subset comprising elements in the other form corresponding to the selected independent claim and all dependent claims referred thereto.

38. (Previously presented) A method as described in claim 37, further comprising one or more of the following:

displaying the selected subsets of elements on a computer screen; and

displaying the selected subsets of elements on a computer screen in combination with other elements of the sets.

39. (Previously presented) A computer program product for generating a derivative document from a patent document, comprising a computer usable medium having computer readable program code means embodied in said medium for causing said computer to perform the steps of the method as described in claim 1.

40. (Previously presented) A computer program product for generating a derivative claim section of a patent document, comprising a computer usable medium having computer readable program code means embodied in said medium for causing said computer to perform the steps of the method as described in claim 15.

41. (Canceled)

42. (Canceled)

43. (Previously presented) A method as described in claim 1, wherein the step (i) further comprises one of the following:

adding single dependent claims generated from multiple dependent claims to the end of original set of claims; or

inserting claims generated from a multiple dependent claim into original set of claims immediately after the multiple dependent claim, followed by re-numbering of claims starting from the multiple dependent claim and to the end of claim section.

44. (Canceled)

45. (Canceled)

46. (Canceled)

47. (Canceled)

48. (Canceled)

49. (Canceled)

50. (Canceled)

51. (Previously presented) A computerized system for generating a derivative claim section of a patent document, the system comprising a computer having a memory, said memory comprising:

(a) means for processing the claim section, including:

- (i) means for transforming multiple dependent claims into single dependent claims;
- (ii) means for sorting the transformed claims by claim numbers to which the claims refer to;
- (iii) means for interchanging positions of any two neighboring sorted claims, the preceding claim and the succeeding claim, if they meet the following requirements:

- both claims are dependent claims and refer to different claims; and
  - succeeding claim does not refer to the preceding claim; and

(b) means for extracting claim dependency and text of claims from the interchanged claims;

(c) means for converting the extracted claim dependency into a graphical form, comprising a set of graphical elements, each element corresponding to an individual claim or a group of claims;

(d) means for converting the extracted text of claims into a textual form, comprising a set of elements, each element being a text of an individual claim or a text of a group of claims; and

(e) means for forming a derivative claim section by combining the converted graphical and textual elements of the converted claim dependency and text of claims in the order obtained after the step (iii) of interchanging, and associating thereof with a computer program code providing a user interactive selection of a subset of elements in one of the graphical and textual forms, and displaying said subset in the selected form along with the related subset of elements according to the transformed claim dependency in the other form to a user, the elements in the graphical form being displayed in the order obtained after the step (iii) of interchanging.

52. (Previously presented) A method as described in claim 1, wherein the step (f) further comprises associating the derivative claim section with a computer program code providing a user interactive selection of a subset of elements in one of the graphical and textual forms, and displaying said subset in the selected form along with the related subset of elements according to the transformed claim dependency in the other form to a user, the elements in the graphical form being displayed in the order obtained after the step (iii) of interchanging.



53. (Previously presented) A method as described in claim 1, wherein the step (c) of extracting claim dependency comprises forming a respective triplet for each interchanged claim, the triplet comprising first, second and third elements which are respectively as follows:

a claim number;

a vertical offset, characterizing a vertical position of the claim, which is defined by the relative position of the claim compared to the first claim in the interchanged set of claims;

a horizontal offset, characterizing a horizontal position of the claim, which is defined by the level of claim dependency for the claim.

54. (Currently amended) A method as described in claim 53, wherein the step (d) of converting comprises converting said triplets into respective graphical elements which are arranged into a ~~substantially~~ linear tree, wherein vertical and horizontal positions of the graphical elements in the tree are defined by the vertical and horizontal offsets in the respective triplets.

55. (Previously presented) A method as described in claim 54, wherein the step (c) further comprises forming a corresponding quadruplet for each interchanged claim, the quadruplet comprising the respective triplet and a fourth element, which is a text of the claim.

56. (Currently amended) A method as described in claim 55, wherein the step (f) comprises a simultaneous displaying a subset of graphical elements from said ~~substantially~~ linear tree along with the related subset of fourth elements from the quadruplets.

**REMARKS****RE: Information Disclosure statement**

With regard to the dates, the Applicant states that the non-patent literature listed in the IDS, that was initially submitted at filing and re-submitted with the Applicant's response dated October 25, 2005, was known to the Applicant prior to the filing date of the present application.

A *bona fide* attempt was made by the Applicant to comply with §1.98 at the time of re-submission of the IDS, but part of the required content such as author, page numbers and place of publication was not available from the websites cited in the IDS, and therefore the Applicant was unable to provide this information to the Examiner.

The Applicant cannot provide the above noted additional information for the website citations listed in the IDS as it continues to be unavailable.

**RE: Claim Rejections 35 USC §101**

Claims 12, 24, 46 and 47 have been canceled without prejudice.  
Thus, the rejections under 35 USC §101 have been overcome.

**RE: Claim Rejections 35 USC §112**

Claims 54 and 56 have been amended to avoid indefinite language.  
Thus, the rejections under 35 USC §112 have been overcome.

**RE: Claim Rejections 35 USC §102(e)**

The Examiner has rejected claims 1, 2, 5, 7-16, 19, 21-27, 37-40, 43, 46, 47, 51 and 52 as being anticipated by RIVETTE (US 6,339,767).

The examiner's rejections under 35 USC §102(e) with regard to claim 1 are respectfully traversed for the following reasons.

The Examiner's attention is drawn to claim 1 in this application, and in particular to the step:

"... (b) processing the claim section, including:

(i) transforming multiple dependent claims into single dependent claims;  
**(ii) sorting the transformed claims by claim numbers to which the claims refer to;**

**(iii) interchanging positions of any two neighboring sorted claims, the preceding claim and the succeeding claim, if they meet the following requirements:**

**both claims are dependent claims and refer to different claims; and succeeding claim does not refer to the preceding claim; ..."**

As explained in the Applicant's previous response dated October 25, 2005 and during telephone interview with examiners Nathan Hillery and Doug Hutton on December 01, 2005, the steps of claim 1, including the steps (ii) and (iii), form a particularly simple and efficient method, which minimizes the processing time and guarantees the correct results for transforming, sorting, and interchanging claims in preparation for displaying.

In particular, the Applicant has proved a Theorem described in paragraphs [55-57] of the detailed description, on which the method of claim 1, including the steps (ii) and (iii), relies, in order to ensure that the steps of the method of claim 1 preserve the original claim dependency.

Contrary to the examiner's statement in sections 16 and 28 of the examination report, the Applicant states that the above noted steps (ii) and (iii) are not present in RIVETTE.

For further convenience, the examiner's "newly cited passage of Rivette" in rejection under 35 USC 102(e) and in Figs 181 and 183 (see Rivette, Column 123, line 59 - Column 124, line 12) is reproduced below:

*"Some well known hyperbolic browser implementations are capable of generating and displaying hyperbolic trees directly from DAGs. These hyperbolic browser implementations conceptually operate by mapping the root node in the DAG to the root node in the hyperbolic tree. Also, non-root nodes in DAG that have a single parent node are directly mapped to corresponding nodes in the hyperbolic tree. These hyperbolic browser implementations conceptually map non-root nodes in the DAG that have multiple parent nodes to multiple nodes in the hyperbolic tree, wherein each of these tree nodes are linked to a single parent node in the hyperbolic tree. This is shown in FIG. 179, where node D has parent nodes B and C in DAG 17902. As a result of this conceptual mapping process in hyperbolic browser, nodes 17906A and 17906B are created in the hyperbolic tree 17904. Each of these nodes 17906A and 17906B is linked to a single parent node (that is, nodes B and C) in the hyperbolic tree 17904. The process of generating and populating a hyperbolic tree from a DAG by such hyperbolic browser implementations will be apparent to persons skilled in the relevant art(s)."*

The above noted passage of Rivette deals with hyperbolic browsers, DAGs, hyperbolic trees, and the process of generating and populating a hyperbolic tree from a DAG using a hyperbolic browser, with Figs 181 and 183 of Rivette illustrating this process.

The examiner's attention is drawn to the fact that the present invention is neither concerned with hyperbolic browsers, nor DAGs, nor hyperbolic trees, nor generating and populating a hyperbolic tree from a DAG by using a hyperbolic browser.

Therefore, the above cited passage of Rivette (Column 123, line 59 - Column 124, line 12) is irrelevant to the present invention.

In particular, the above noted "newly cited passage of Rivette" (Column 123, line 59 - Column 124, line 12) does not teach the steps (ii) and (iii) of claim 1 of the present invention.

In case of disagreement, the examiner is respectfully requested to point out specifically which lines of the above noted "newly cited passage of Rivette" (Column 123, line 59 - Column 124, line 12) teach the step (ii) of claim 1, and which lines teach the step (iii) of claim 1.

Moreover, the processing steps (ii) and (iii) of claim 1 are not taught anywhere else in Rivette. In case of disagreement, the examiner is respectfully requested to point out specifically which lines of Rivette teach the step (ii) of claim 1, and which lines teach the step (iii) of claim 1.

Accordingly, RIVETTE does not teach each and every element of claim 1 of the present invention.

Therefore the rejection under 35 USC §102(e) as anticipated by RIVETTE is requested to be withdrawn.

**RE: Claim Rejections under 35 USC §103(a)**

Claims 53-56 have been rejected under 35 USC §103(a) over RIVETTE (US 6,339,767).

Claims 53-56 depend on claim 1 and include all limitations of claim 1, which is neither anticipated (see arguments presented above) nor is obvious in view of RIVETTE for the following reasons.

In order to lead to claim 1 of the current invention, RIVETTE would need to perform the following additional steps, namely:

1. (ii) to sort the transformed claims by claim numbers to which the claims refer to;
2. (iii) to interchange positions of any two neighboring sorted claims, the preceding claim and the succeeding claim,
3. then to impose further limitations to the interchanging step (iii), namely to identify that:  
both claims, whose positions to be interchanged, have to be dependent claims and refer to different claims;
4. and then to impose yet another limitation that:  
succeeding claim does not refer to the preceding claim; ..."

Clearly, the above noted combination of steps 1-4 cannot be considered obvious.

In addition, someone skilled in the art would have to prove a Theorem, on which the method of the current invention relies (see paragraphs [55-57] of the specification) to ensure that the method steps work properly. Indeed, the method of computerized processing, which would require the proof of the corresponding Theorem, cannot be considered obvious.

There is also no motivation or suggestion in RIVETTE to perform the above noted processing steps. The law is well established that the imperus for combining or modifying references must be found in the references themselves, not in the pending application, see e.g. *Orthopedic Equip. Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983), and a recent case *Teleflex v. KSR International*, where Federal Circuit set forth an elevated standard for finding a motivation to combine or modify references (namely, a motivation to combine prior art reference "in the particular manner claimed" in a patent).

Therefore the Examiner's rejections under 35 USC §103(a) are requested to be withdrawn.

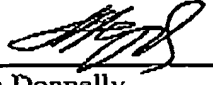
Other independent claims 15, 25 and 51 have scope similar to that of claim 1.

Other dependent claims depend on claims 1, 15, 25 and 51 and introduce further limitations.

The Examiner is requested to respectfully reconsider this application with regard to the arguments presented above and with a view to considering the claims favorably for allowance.

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